

REMARKS

Reconsideration and removal of the grounds for rejection are respectfully requested. Claims 1-23 were in the application, claims 5 and 10-23 were withdrawn, claims 1 and 8 have been amended, claims 2, 4 and 7 have been cancelled.

Claims 1-3, and 7-9 were rejected as being anticipated by Krotzer. However, by the above amendment, the limitations of claims 4 and 7 have been incorporated into claim 1 and consequently, this rejection is rendered moot.

Similarly, the rejection of claims 1, 6 and 9 as being anticipated is rendered moot by the amendment.

Claims 1-4 and 6-9 were rejected as being obvious over Krotzer and Winston et al. It is conceded that Krotzer fails to disclose Rhodia Rosea extract as part of the composition of Krotzer. The Examiner considers it obvious to use such an extract in the Krotzer composition, and that the amounts according to the limitations of claim 7, now incorporated in claim 1 would be a mere matter of optimization. However, this is nothing more than a hindsight reconstruction, as there are literally hundreds of possible combinations of ingredients that could be made from these patents, and nothing to lead one to the applicants' invention.

In order to uphold a finding of obviousness, there must be some teaching, suggestion or incentive for doing what the applicant has done. ACS Hospital Sysys. Inc. v. Montefiori Hospital, 723 F.2d 1572 (Fed. Cir. 1984). Also, "Both the suggestion and the expectation of success must be found in the prior art, not in the applicant's disclosure." In re Dow Chemical Co., 837 F.2d 469 (Fed. Cir. 1988).

The Patent and Trademark Office has the burden under section 103 to establish a prima facie case of obviousness. In re Piasecki 223 USPQ 2d 785 (Fed. Cir. 1984). They can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to an ordinary skill in the art would lead the individual to combine relevant teachings of the references. In re Fine, 837 F.2d 1071 (Fed. Cir. 1988).

While individually, the ingredients may be known in the art, "it is irrelevant in determining obviousness that all other aspects of the claimed invention are well known in a piecemeal manner, in the art, since virtually every patent can be described as a 'combination

patent', or a 'combination of old elements'. The mere fact that the disclosure of teachings of the prior art can be retrospectively combined for purposes of evaluating the obviousness/non-obviousness issue does not make the combination obvious unless the art also suggested the desirability of the combination or the inventor's beneficial results of the advantage to be derived from the combined teaching." Fromson v. Advanced Offset Plate, Inc. 755 F. 2d 1549, 1556 (Fed. Cir. 1985). At best it might be obvious to try various combinations, but obvious to try is not the standard.

A relevant case is In re Fine, 5 U.S.P.Q. 2d 1596 where the CAFC reviewed an obviousness rejection where the claimed invention, a system for detecting and measuring nitrogen compounds was considered obvious in view of a similar system used for monitoring sulfur compounds, combined with a disclosure of a nitrogen detector. The Court held "The Eads and Warnick references disclose, at most, that one skilled in the art might find it 'obvious to try' the claimed invention. But whether a particular combination might be 'obvious to try' is not a legitimate test of patentability (cite omitted)..." teachings of references can be combined only if there is some suggestion or incentive to do so" Id. at 1599. The Court also held that the Board failed to recognize that an advantage of the invention was not appreciated by the prior art, i.e., a temperature limitation which prevented measurement distortion. Id at 1600.

These cases are similar to the present case, as there is no teaching or suggestion which would guide one skilled in the art to pick and choose among the numerous ingredients in Krotzer to select the specific components of the applicants invention, and then to pick again among the numerous ingredients in Winston, to arrive at the composition according to claim 1. Certainly, there is no indication of any advantage to making such a combination. As the Court stated in Fine:

"The Examiner relies on hindsight in reaching his obviousness determination. But the court has said, 'To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher. W.L. Gore, 721 F. 2d at 1553, 220 USPO at 312-13. It is essential that the decision maker forget what he or she has been taught at trial about the claimed invention and cast the mind back to the time the invention was made...to occupy

the mind of one skilled in the art who is presented only with the references, and who is normally guided by the then-accepted wisdom in the art. *Id.* One cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to depreciate the claimed invention. In re Fine, *supra*.

The applicants' invention is an oral composition containing specific ingredients, in specific ranges which solves a problem, that is, it suppresses both appetite and cravings for substances such as nicotine. There is no teaching or suggestion for preparing such a specific composition in the cited references, not any indication of the advantages obtained using the composition. Consequently, claims 1, 3, 4, 6, 8 and 9 are not obvious, and this rejection should be withdrawn.

The rejection claims 1-3 as being obvious over Mann et al is rendered moot by the amendment to claim 1, to include the limitations of claims 4 and 7 therein.

Based on the above amendment and remarks, favorable consideration and allowance of the application are respectfully requested. However should the examiner believe that direct contact with the applicant's attorney would advance the prosecution of the application, the examiner is invited to telephone the undersigned at the number given below.

Respectfully submitted,



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